

REMARKS

Claims 1-44 are presently pending. **Claims 25-44** are canceled. **Claims 45-50** are newly added. Applicant has concurrently filed a Request for Continued Examination (RCE) with this Amendment. In the above-identified Office Action, **Claims 1-11** and **15-24** were rejected under 35 USC 102(e) as being anticipated by Mitchell (US 2003/0149661 A1). **Claims 12-14** were rejected under 35 USC 103(a) as being unpatentable over Mitchell in view of Kipp (U.S. Patent No. 5,239,167).

By this Amendment, Applicant has amended the claims to distinguish over Mitchell and Kipp and has added an independent method **Claim 45** and associated dependent **Claims 46-50**. Method **Claim 45** is added per MPEP 806.05 with the understanding that the process for using (e.g., **Claim 45**) the apparatus (e.g., **Claim 1**) is not patentably distinct from the apparatus (**Claim 1**) such that the process (**Claim 45**) cannot be used to practice another materially different or mutually exclusive apparatus (**Claim 1**) and that the apparatus (**Claim 1**) cannot be used to practice another materially different or mutually exclusive process (**Claim 45**). Applicant maintains that restriction would be also improper to the extent that the inventions are not mutually exclusive, as they overlap in scope (MPEP 806.05(j)). Applicant asserts that claimed inventions are only mutually exclusive when a first invention would not infringe a second invention, and the second invention would not infringe the first invention (MPEP 806.05, ¶ 2). For example, an embodiment implemented according to **Claim 1** could infringe **Claim 45**, and consequently, the claimed inventions overlap in scope and are therefore not mutually exclusive. Hence for two claims to be mutually exclusive, the invention of one claim must exclude the invention of the other claim such that one invention would necessarily not infringe the other. In summary, the invention of **Claim 45**, for example, would not exclude the invention of **Claim 1**, and consequently, the claims are not mutually exclusive, and restriction would be improper.

For reasons set forth below, the present Application is submitted as properly defining an invention patentable over the prior art. Reconsideration, allowance, and passage to issue are respectfully requested.

Introduction

The art of record (e.g., Mitchell et al., US 2003/0149661 A1, herein simply called Mitchell) generally teaches modifying existing transaction infrastructure, such as clearing houses, bank accounts, and so on, to enable the infrastructure to use biometric information to complete a transaction. Unfortunately, such infrastructure modification is undesirable for reasons set forth below, and information maintained by infrastructure is not readily user editable or modifiable, which is also undesirable. Furthermore, the requisite infrastructure modifications disclosed in Mitchell would obviously require clearing house and bank acceptance before such changes could be made and before Mitchell could be implemented, which could be prohibitive. Furthermore, in Mitchell, a user's biometric information may be undesirably proliferated among banks and clearing houses, which may increase exposure to fraud.

One embodiment within the scope of the present claims provides a system for facilitating transactions that requires little or no modification to existing clearing houses, financial accounts, e.g., bank or credit card accounts, and so on, and which may readily be adapted for use with existing Point of Sale (POS) terminals and transaction infrastructure, such as clearing houses and bank accounts; does not require proliferation of stored biometric information among clearing houses and banks; does not require acceptance of the invention by banks and clearing houses; and so on. Existing infrastructure (e.g., clearing houses and banks) is currently configured to handle account numbers, such as credit card and charge card numbers, and is not typically configured to handle biometric information to implement transactions. Accordingly, in one claimed embodiment, biometric information is used to retrieve an account number to the existing infrastructure by delivering the account number to a charging terminal for the purposes thereafter of making a charge via the account number and existing infrastructure (e.g., Claim 1, 22, 45). Consequently, for embodiments

constructed according to the present claims, existing infrastructure, such as clearing houses, bank accounts, credit card accounts, and so on, does not require modification, since the infrastructure is already equipped to make charges in response to receipt of an account number.

In a more specific claimed embodiment, the account number is retrieved from a user-modifiable database (e.g., **Claim 3, 15, 49**) that may be positioned remotely from a clearing house. This enables additional benefits. For example, in one implementation falling within the scope of the claims, a user may change biometric information and may change associations between biometric information and financial accounts as needed. For example, if a user believes that someone has acquired his/her thumbprint and is making fraudulent charges, the user may readily disable use of the thumb print and enable use of another biometric (or combination of biometrics), such as pointer-finger print, by accessing the database and making appropriate changes.

Existing systems generally do not enable a user to readily access, change, or modify associations (or automatic account selection rules) between biometric information and existing accounts. Generally, the user must apply, such as to MasterCard ([e.g., 0055] of Mitchell), to use biometric information to charge a special account (e.g., fingerprint credit card account -- [0051] of Mitchell). Information associated with any new special accounts, such as fingerprint credit card accounts, must then be propagated through (and proliferated in) the infrastructure so that the clearing house and/or other participating entities can appropriately handle the biometric information. Undesirable time consuming proliferation of the biometric information may increase exposure to fraud. Furthermore, unlike the invention as claimed (e.g., **Claims 3, 5, 6, 18, 50**), account selection in Mitchell is not automatic. Mitchell generally requires additional user input (which is not automatic) at a POS terminal, which may delay shopping lines (e.g., [0048]-[0050] of Mitchell).

Rejections Under 35 U.S.C. 102(e)

Hence, Mitchell generally requires participation of a clearing house and may further require additional manual user input at the point of sale to select from among plural accounts

(e.g., Mitchell requires manually pressing "OK" [0050], last sentence, and/or using "controls" [0049]). Furthermore, such systems generally lack any functionality or mechanisms that would enable a user to readily change how the system operates, such as which accounts are automatically selected in response to different biometric input. In general, Mitchell would require not only acceptance by both a clearing house and a credit/charge card company, but would require costly modification to existing infrastructure to update the functionality and/or account organization at the clearing house and the credit/charge card companies.

The invention is set forth in claims of varying scope. **Claim 1** is illustrative. **Claim 1** as amended recites:

1. A system for facilitating transactions comprising:
a charging terminal for charging an account based on an account number;
a scanner for obtaining biometric information; and
first means for employing said biometric information to provide said account number to said charging terminal. said charging terminal adapted to initiate charging said account upon or after being provided said account number by said first means. (Emphasis added.)

Rejections of the previously presented **Claim 1** under 35 U.S.C. 102(e) in view of Mitchell generally maintain that Mitchell discloses a means for employing biometric information to provide an account number to the same POS charging terminal used to charge an account. However, any account number retrieved to the charging terminal of Mitchell would not be used to subsequently initiate a charge via the POS terminal as presently claimed. No charging terminal disclosed in Mitchell receives an account number in response to biometric information and then uses that account number to thereafter make a charge (e.g., Claims 1, 22, 45), such as via preexisting infrastructure. Accordingly, Mitchell does not teach, disclose, or suggest the first means as recited in **Claim 1** and certainly does not teach providing an account number to a POS for the purposes of charging the account number via a POS or other preexisting infrastructure.

Applicant provides an entirely different system/method to use biometric information to make charges, and this system may enable significant benefits over the art of record, such as discussed in Applicant's Amendment C (e.g., in the section beginning on p. 26 of

Amendment C). Furthermore, such a system need not be implemented at a clearing house, and implementation of the system does not require costly modification to an existing clearing house or repetitive modification to different bank or charge card accounts, and the system does not require acceptance by associated clearing houses and banks.

Furthermore, nowhere does Mitchell disclose or suggest: retrieval of a PIN to a POS based on biometric information for the purposes thereafter of making a charge (e.g., **Claim 2**); a mechanism that enables a user to control retrieval of account numbers to a POS from a user-modifiable or remote database or any entity (e.g., **Claim 4**); a mechanism for facilitating prioritizing accounts for automatic retrieval to a POS (e.g., **Claim 5**) (-use of keys to choose between charge card companies (e.g., [0050] of Mitchell) in no way teaches prioritization or automatic retrieval of a highest priority account); a mechanism that enables a user to specify selection rules based on transaction information (e.g., **Claim 8**) (-instead, Mitchell merely discloses the notion of associating different biological identifiers with different accounts, which would be manually selected (e.g., [0049]-[0050] of Mitchell)), and selection would not bc bascd on transaction information; account sclection performed in Mitchell requires manual non-automatic user manipulation of controls (e.g., Mitchell [0049]-[0050]) regardless of whether different finger prints are associated with different accounts (e.g., **Claims 3, 5, 6, 18, 50**); transmission of a PIN to a clearing house as purportedly suggested in Mitchell is entirely different than employing transaction type information to limit automatic selection of account numbers (e.g., **Claim 9**); any database taught in Mitchell would not be user-accessible for modification, and Mitchell does not teach use of a user-modifiable database (e.g., **Claims 10, 15, 49**).

Claim 15 as amended recites:

15. A system for facilitating a financial transaction comprising:

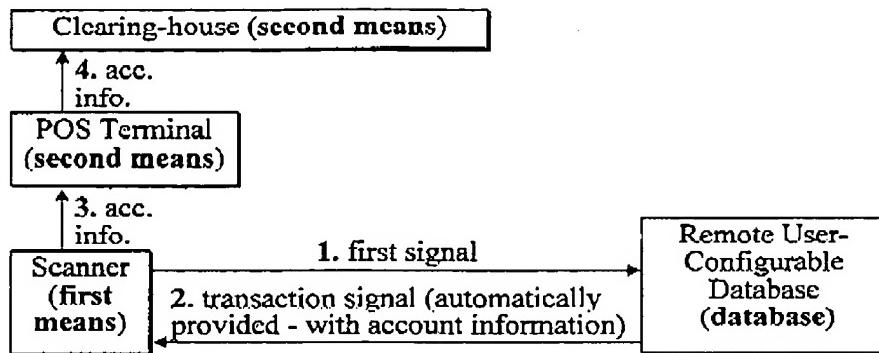
first means for measuring one or more biological characteristics of a user;

a database that is modifiable by a user of said system, wherein said database is adapted to select an account associated with said user based on said one or more biological characteristics and to provide a transaction signal in response thereto; and

second means for implementing a funds transfer to or from said selected account in accordance with said financial

transaction in response to said transaction signal. (Emphasis added.)

The following simplified diagram, which based on diagrams in the Application, is shown for illustrative purposes:



Selection of accounts in Mitchell is not automatic, but requires user manipulation of controls and arrow keys (e.g., **Claim 18**) to select what type of card will be used (e.g., [0049]-[0050] of Mitchell).

The database in Mitchell is not user modifiable (e.g., **Claim 15**), as it is unlikely (and not taught in Mitchell) for a user to be able to modify clearing house databases. Based on the above-identified Office Action, the “database” purportedly disclosed in Mitchell would be “controls and arrow keys,” (as discussed in the above-identified Office Action in rejecting **Claim 18**), which is entirely different than a database that does not require participation of a clearing house (e.g., **Claims 16, 24, 47, 48**). Any database in Mitchell would be at a clearing house and would be entirely separate from a means for automatically selecting an account from plural accounts, and any database in Mitchell would be different than controls and arrow keys. Note that paragraphs [0018]-[0021] of Mitchell are paraphrased claim language that describes mechanisms that are discussed more fully in the “Preferred Embodiments” section of Mitchell, where Mitchell makes clear that the database discussed, for example in [0018] of Mitchell must be at the clearing house (e.g., [0052]) (e.g., **Claims 16, 24, 47, 48**).

Nowhere does Mitchell disclose outputting account information contained in a transaction signal via a user modifiable database that automatically selects an account from plural accounts (e.g., **Claim 17**).

As discussed above, information stored in machine readable form in Mitchell ([0023]) is not taught as being readily user-editable (e.g., **Claim 18**). Users are unlikely to be allowed to edit a clearing house database, and any such database would require participation of a clearing house, which is contrary to the last limitation in **Claim 16** from which **Claims 17 and 18** depend.

In addition, nowhere does Mitchell teach, disclose, or suggest a computer or any other mechanism that would enable a user to configure or access information stored in a database (e.g., **Claim 19**), and especially a database that does not require participation of a clearing house or is positioned remotely from a clearing house (e.g., **Claims 16, 24, 47,48**).

Nowhere does Mitchell disclose use of predetermined account-selection rules for accounts in a remote database that does not require participation of a clearing house (e.g., **Claim 20**).

The EFTPOS terminal in Fig. 1 of Mitchell does not enable a user to predetermine account selection rules but merely enables a user to choose accounts, which is entirely different than determining selection rules (e.g., **Claim 21**). The EFTPOS (Electronic Funds Transfer Point of Sale) terminal of Mitchell is not remotely positioned from a point of sale, but is taught as being at the point of sale as indicated by its name. It is merely called a remote terminal, as it is not incorporated within the standard POS terminal itself, although the “remote terminal” of Mitchell (EFTPOS) is still at the point of sale as indicated by its name, and as would be required to enable use of the system as taught in Mitchell.

Contrary to the rejection of **Claim 22**, the “good scan” of Mitchell could in no way be used to authenticate a user before a transaction signal is sent to a clearing house, as any authentication in Mitchell occurs at the clearing house. Furthermore, any charging terminal (which may be analogous to the second means of **Claim 15**) disclosed in Mitchell would not be configured to charge an account upon or after receipt (e.g., **Claims 1, 22, 45**) of a transaction signal received from a user-modifiable database in response to biometric information (e.g., **Claim 22**).

Nowhere is a “transaction signal” of Mitchell disclosed as being provided to a POS (e.g., charging module, **Claim 24**) or to a second means as claimed (e.g., **Claim 15**) for the purposes of subsequently making a charge. For example, the above-identified Office Action suggests that the purported “transaction signal” (e.g., as used to reject **Claim 15**) is sent to the clearing house instead (as would have to be to reject **Claim 15**). Note that the database of Mitchell (used to reject **Claim 17**) is at the clearing house. Furthermore, the clearing house of Mitchell is not shown including a POS (e.g., credit card, charge card, and ATM charging module). In addition, any database of Mitchell would not be remotely positioned from a clearing house (e.g., **Claim 24**).

Nowhere does Mitchell disclose storing biometric information when an authentication of a user fails before information is sent to a clearing house (e.g., **Claim 23**).

Rejections Under 35 USC 103(a)

Note that Kipp (U.S. Patent No. 5,239,167) does not apparently disclose or suggest disabling of anti-theft features on a tag (e.g., **Claim 14**). Note that the distress signal emitted by a tag of Kipp is not an anti-theft signal, but a distress signal that alerts an employee to a product that may, for example, require manual pricing (as discussed in column 4, lines 39-48 of Kipp). Furthermore, the distress signal is only triggered after the tag is activated at the checkout. A thief is unlikely to pass a checkout line to activate a tag before exiting a merchant outlet.

Hence, claimed embodiments are unobvious and encompass embodiments with several key advantages over the art of record. For example, certain embodiments afford the ability to use existing infrastructure, such as a clearing house and/or charging terminal, with little or no modification made thereto, and to use biometric information to input an account number to the preexisting infrastructure. Such advantages weigh in favor of patentability, as discussed more fully in Applicant’s Amendment C (e.g., pages 26-33 thereof).

Request per MPEP 707.07(j)

If Examiner agrees that patentable material exists but does not feel that the present claims are technically adequate, Applicant respectfully requests that Examiner make appropriate suggestions or write acceptable claims pursuant to MPEP 707.07(j).

Conclusion

None of the references cited by Examiner taken alone or in combination teaches, discloses, or suggests the invention as presently claimed. For example, none of the references shows a system that can employ biometric information to automatically provide or send an account number to a charging terminal for subsequently making a charge via the charging terminal (e.g., **Claim 1, 22, 45**). Furthermore, none of the references shows use of a user-modifiable database (e.g., **Claim 15**)

The present Application is believed to be in proper form for allowance. Accordingly, allowance, and passage to issue are respectfully requested.

I hereby certify that this correspondence is either being transmitted to the United States Patent and Trademark Office at 571-273-8300 or is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450, on December 24, 2007.

Respectfully submitted,

Robert de Sylva 12 - 24 - 07

Robert de Sylva (Applicant)

Robert de Sylva,
161 Ocean Park Blvd. #D
Santa Monica, CA 90405
Phone: 310-452-4579